

**REMARKS**

The Office Action mailed on November 09, 2004, has been reviewed and the comments of the Patent and Trademark Office have been considered. Prior to this paper, claims 1-96 were pending, with claims 48-50, 52, 85-91, 94 and 95 being withdrawn. By this paper, Applicant does not cancel any claims, and adds claim 97. Therefore, claims 1-97 are now pending.

Applicant respectfully submits that the present application is in condition for allowance for the reasons that follow.

**Indication of Allowable Subject Matter**

Applicant thanks Examiner Phan for allowing claims 27-31, 36-47, 53-84 and 96.

**Interview of March 08, 2005**

Examiner Phan is thanked for extending the courtesy of an interview to Applicant's representative on March 08, 2005, where it was agreed that if claim 17 was placed into independent form, and claims 1, 92 and 93 were amended to recite a "thin sheeted substrate," the prior art rejections would be overcome.

In view of the Personal Interview held on March 08, 2005, Applicant submits that the above discussion and the Interview Summary (a copy of which is attached) provides a complete and proper recordation of the substance of the interview, per MPEP §713.04.

**Obviousness-Type Double Patenting Provisional Rejections**

Claims 92 and 93 were rejected under the judicially created doctrine of obviousness-type double patenting in view of claims 1 and 25 of U.S. Patent No. 6,614,392. In response,

in order to advance prosecution, Applicant submits a terminal disclaimer along with this letter, and respectfully request withdrawal of the rejections in view of the terminal disclaimer.

**Rejections Under 35 U.S.C. § 102**

Claims 1-26, 32-35 and 51 stand rejected under 35 U.S.C. §102(e) as being anticipated by Black (United States Patent Application No. 2002/0178369). Further, claims 92-93 stand rejected under 35 U.S.C. §102(e) as being anticipated by Durst (United States Patent No. 6,441,778) or by Stephens (United States Patent Application No. 2002/0014953). In response, in order to advance prosecution, as was agreed during the interview of March 08, 2005, Applicant places claim 17 into independent form, and, without prejudice or disclaimer, amends claims 1, 92 and 93 to recite that the substrate is a “thin sheeted substrate.” Applicant further amends claims 32, 51 to recite a “thin sheeted substrate,” in order to advance prosecution, without prejudice or disclaimer. In an exemplary embodiment, a thin sheeted substrate, such as by way of example, a sheet of paper, is processed by a printing machine to produce an intelligent label(s) according to the present invention.

Applicant respectfully submits that the above claims are allowable for at least the reason that each and every element of the claims is not set forth, either expressly or inherently, in a single prior art reference, per MPEP § 2131, entitled “Anticipation – Application of 35 U.S.C. 102(a), (b), and (e).”

**The Phrase “Thin Sheeted” is Definite Under 35 U.S.C. §112, Second Paragraph**

Applicant respectfully submits that the skilled artisan would understand what is meant by a “thin sheeted substrate” in view of the teachings of the specification in general, and in view of the teachings at paragraphs 0076-0078 of the specification in particular. Applicant relies on MPEP §2173.05(b), entitled “Relative Terminology,” which states that the “fact that claim language, including terms of degree, **may not be precise, does not automatically** render the claim indefinite . . . Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.” (Emphasis added, citations omitted.) Moreover, the definition of “sheet,” which is “a broad,

*thin* usually rectangular mass or piece of any material, as paper, metal, glass, or plywood,” utilizes the word “thin,” and thus the term “thin” in front of the term “sheeted” merely affirmatively recites an inherent feature of a sheeted substrate.

**Request for Rejoinder of Withdrawn Claims**

Claims 48-50, 52, 85-91, 94 and 95 were withdrawn in a prior Office Action. Applicant notes that these claims, as amended, now depend either directly or ultimately from non-withdrawn claims, many of which were previously allowed, and all of which are currently allowable as discussed above. Applicant respectfully requests that these claims be rejoined and allowed due to their dependency from allowable claims. Applicant respectfully submits that no significant burden is placed on the PTO by rejoining and examining these claims. Indeed, such action is concomitant with the indication that “upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim.”

For example, withdrawn claims 48 depends from claim 1, and thus is allowable for at least the reasons that make claim 1 allowable.

Withdrawn claims 49 and 50 ultimately depend from claim 39, an allowed claim.

Withdrawn claim 52 now depends from claim 1, and thus is allowable for at least the reasons that make claim 1 allowable.

Withdrawn claims 85-91 now ultimately depend from claim 53, an allowed claim.

Withdrawn claims 94 and 95 now depend from claim 92, and thus are allowable for at least the reasons that make claim 92 allowable.

Rejoinder and allowance is respectfully requested.

**Conclusion**

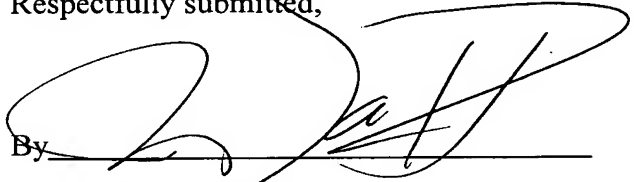
Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Examiner Phan is invited to contact the undersigned by telephone if it is felt that a telephone interview may advance prosecution.

Respectfully submitted,

Date March 09, 2005

By 

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